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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Alan Derek Dean

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EXAMINER

PATEL, HARESH N

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,760

Applicant(s)

DEAN, ALAN DEREK

Examiner

Haresh Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20 are subject to examination.

Response to Arguments

2. Applicant's arguments filed 5/15/2006, pages 7-21, have been fully considered but they are not persuasive. Therefore, rejection of claims 1-20 is maintained.

Applicant argues (1), "the combined references do not disclose, teach, or suggest the applicant's claimed invention, i.e., "it is not necessary that the users have prior existing conventional email addresses, providing a database with structured standardized unique master indexes for every recipient that can themselves be used as e-mail addresses and to which other data including existing conventional e-mail addresses can be attached and identified".

The examiner respectfully disagrees in response to applicant's arguments. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies, "it is not necessary that the users have prior existing conventional email addresses, providing a database with structured standardized unique master indexes for every recipient that can themselves be used as e-mail addresses and to which other data including existing conventional e-mail addresses can be attached and identified", are not recited in the rejected claim(s), please see the claimed subject matter of claims 1 and 7.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The First inquiry must be into exactly what the claims define.

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See *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970). Please refer to the office action dated 11/16/2005 for the rejections of the claimed subject matter of the claims.

The applicant is contradicting with his own previous assertions, for example, structuring electronic mail addresses so as to make them uniform, please see page 1, lines 28-29 of the specification of this application under prosecution and the applicant asserted, dated 8/26/2005, that the claimed invention includes generating a set of standardized electronic mailing addresses, i.e., this standardization allows indexing by district or name and address and can be made available to potential users of the telephonic system in a variety of convenient ways, wherein, (address) is allocated centrally according to a national pattern. The referencing information attached to this telephone number is also collected in a uniform way and to provide a standardized system for structuring electronic mail addresses so as to make them uniform, also please see specification of this application, page 2, lines 22 – 29), which the applicant is again conflicting with the arguments.

Since, applicant's claims contain **broadly claimed subject matter**, it clearly reads upon the examiner's interpretation of the claimed subject matter. Therefore, the rejection is maintained.

Applicant argues (2), “Hall is apparently directed to restricting unwanted or junk mail, restricting hate mail, restricting advertisements and prevention of undesirable e-mail”, “Pena is apparently directed to assisting unskilled users and others without computers to transfer data and communicate”, “users are assigned a unique e-mail address that would be added to a computer database of subscribers”, “Ramey is apparently directed to receiving and send/resending

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communications in different media and using table of figure 2 as being used in a look-up manner in order to potentially identify the sender”, hence, the cited references are believed to be directed to completely different systems and methods that solve vastly different problems and the Hall appears to teach away from the proposed combination.

The examiner respectfully disagrees in response to applicant's arguments. The teachings and/or disclosures of the Hall, Ramey and Pena are **not limited** to as per the above-mentioned applicant's assertions. Please refer to the office action dated 11/16/2005 for the rejections of the claimed subject matter of the claims as the Hall, Ramey and Pena references **also** disclose the relied upon limitations. The applicant's assertions and assumptions that the systems of the Hall, Ramey and Pena are different is simply **incorrect** as the claimed invention is related to handling and/or facilitate the electronic mail addresses, which the cited references are also concerned about. In fact, the claimed invention is **not limited** to a particular system, including Hall disclosed systems, Ramey disclosed systems, Pena disclosed systems, etc., The applicant's assertions that the claimed invention is different and do not perform what the Hall disclosed systems, Ramey disclosed systems and Pena disclosed systems support, the claimed subject matter of the claims is **too broad** and do not mention that it is **only used** for generating a set of standardized electronic mail addresses and not used for other handling of the electronic mail addresses. Applicant's assertion that Hall reference is teaching away is simply incorrect, as the Hall references provide more than one systems and/or methods and different types electronic mail addresses that can be handled which does not mean that they teach away, because Hall provides and/or discloses **alternatives** that can be used. Therefore, the rejection is maintained.

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Applicant argues (3), “the combined references do not disclose, teach, or suggest the applicant’s claimed invention, i.e., “generate an electronic mail address **for** said person based on said personal name code and said location code”.

The examiner respectfully disagrees in response to applicant's arguments. First contrary to the applicant’s assertions, “an electronic mail address” (without “the” or “said”) of line 6 of claim 1 is not the same as “a set of standardized electronic mail addresses” of the preamble of the claim 1 (similar with claim 7). Second, as per applicant’s assertions, the claimed invention is **neither limited to** “it is not necessary that the users have prior existing conventional email addresses, providing a database with structured standardized unique master indexes for every recipient that can themselves be used as e-mail addresses and to which other data including existing conventional e-mail addresses can be attached and identified”, **nor limited to** structuring electronic mail addresses so as to make them uniform, please see page 1, lines 28-29 of the specification of this application under prosecution (please body of the claims), or to generating a set of standardized electronic mailing addresses, i.e., this standardization allows indexing by district or name and address and can be made available to potential users of the telephonic system in a variety of convenient ways, wherein, (address) is allocated centrally according to a national pattern. The referencing information attached to this telephone number is also collected in a uniform way and to provide a standardized system for structuring electronic mail addresses so as to make them uniform, also please see specification of this application, page 2, lines 22 – 29. Pena teaches a program storage device readable by a machine (e.g., col., 4, lines 2 – 34) and encoding a program of instructions (e.g., col., 4, lines 2 – 34) / a system (e.g., col., 4, lines 2 – 34) for generating a set of electronic mail addresses (e.g., col., 13, lines 39 - 66), logic

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configured to provide a personal name code indicative of the name of a person (e.g., col., 4, lines 20 - 54), logic configured to provide a location code indicative of a known location of the person (e.g., col., 7, line 56 – col., 8, line 45), logic configured to generate an electronic mail address (e.g., col., 13, lines 39 - 66) for said person (e.g., col., 4, lines 20 - 54) and logic configured to provide a database of said electronic mail addresses for a plurality of persons at one or more locations (e.g., col., 7, line 56 – col., 8, line 45). Hall discloses a well-known concept of using standardized mail addresses (e.g., col., 5, lines 5 – 38). Ramey discloses a well-known concept of using electronic mail address based on the personal name code and the location code (e.g., col., 5, lines 5 – 38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Pena, Hall and Ramey because the standardization would provide each of the mail address containing common type of information. The mail address providing common type of information would be used to handle the mail addresses. The personal name code and the location code in the electronic mail address would provide information regarding the person and the location. The information regarding the person and the location would be used to handle the mail addresses. Since, applicant's claims contain **broadly claimed subject matter**, it clearly reads upon the examiner's interpretation of the claimed subject matter. Therefore, the rejection is maintained.

Applicant argues (4), “the combined references do not disclose, teach, or suggest the applicant’s claimed invention, i.e., “standardized email addresses to make it easy to identify a recipient’s email address such that e-mails can be delivered to an intended recipient without prior knowledge of the recipient’s email address”.

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The examiner respectfully disagrees in response to applicant's arguments. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies, "standardized email addresses to make it **easy to identify a recipient's email address** such that **e-mails can be delivered** to an intended recipient **without prior knowledge of the recipient's email address**", are not recited in the rejected claim(s), please see the claimed subject matter of claims 1 and 7.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The First inquiry must be into exactly what the claims define. See *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970). Please refer to the office action dated 11/16/2005 for the rejections of the claimed subject matter of the claims. Since, applicant's claims contain **broadly claimed subject matter**, it clearly reads upon the examiner's interpretation of the claimed subject matter. Therefore, the rejection is maintained.

Applicant argues (5), usage of "the personal name code" and "location code" of claims 1 and 7 (at pages 13 and 15 of the remarks) are not disclosed by the cited references.

The examiner respectfully disagrees in response to applicant's arguments. The claims 1 and 7 do not even define what the personal name code and location code is, please see claimed subject matter of claims 1 and 7. (as claims 2, 3, etc that are dependent claims, which define the personal name code and location code). Ramey discloses a well-known concept of using electronic mail address based on the personal name code and the location code (e.g., col., 5, lines 5 – 38). Since, applicant's claims contain **broadly claimed subject matter**, it clearly reads upon

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the examiner's interpretation of the claimed subject matter. Therefore, the rejection is maintained.

Applicant states (6), "Official Notice" should not be used for the limitations because of the specificity of the finding within the claimed combination",

The examiner respectfully disagrees in response to applicant's arguments. The claimed limitations rejected under Official Notice are broad and indeed well known and expected in the art because several references teach the limitations with the claimed combination. Applicant is requested to **not ignore** the **teachings** of the cited references that disclose the teachings of the well known limitations (the rejected claimed subject matter) by the cited arts, i.e., Scroggie et al., 5,970,469, Pennell et al., 2005/0125546, Dovolis, 2001/0034609, Pena, 6,292,211, Pennell et al., 6,874,023, Szutu, 2001/0047391, etc.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 7, 9, 13, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pena, 6,292,211 (Hereinafter Pena) in view of Hall, 5,930,479 (Hereinafter Hall) and Ramey et al., 6,298,128 (Hereinafter Ramey), as per office action dated 11/16/2005.

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5. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pena, Hall and Ramey in view of Toyoda, 6,897,985 (Hereinafter Toyoda), as per office action dated 11/16/2005.

6. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pena, Hall and Ramey in view of Oseto, 6,097,797 (Hereinafter Oseto), as per office action dated 11/16/2005.

7. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pena, Hall and Ramey in view of Grauman, 6,707,472 (Hereinafter Grauman), as per office action dated 11/16/2005.

8. Claims 6, 12, 14, 16, 18, 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Pena, Hall and Ramey in view of Official Notice, as per office action dated 11/16/2005.

Note: cited arts to support the Official Notice are, Scroggie et al., 5,970,469, Pennell et al., 2005/0125546, Dovolis, 2001/0034609, Pena, 6,292,211, Pennell et al., 6,874,023, Szutu, 2001/0047391, etc.

Note: please refer to office action dated 11/16/2005 for the rejections of claims 1-20, which has been maintained in this office action.

Conclusion

9. The prior art made of record (forms PTO-892 and applicant provided IDS cited arts) and not relied upon is also considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Haresh Patel

August 7, 2006



VIET D. VU
PRIMARY EXAMINER